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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,402	04/08/2005	Karlheinz Horsting	DNAG-289	4886
24972	7590	01/21/2010		
FULBRIGHT & JAWORSKI, LLP			EXAMINER	
666 FIFTH AVE			DANIELS, MATTHEW J	
NEW YORK, NY 10103-3198				
			ART UNIT	PAPER NUMBER
			1791	
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			01/21/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/507,402

Applicant(s)

HORSTING ET AL.

Examiner

MATTHEW J. DANIELS

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 20 October 2009 and 5 November 2009 have been entered.

Specification

2. The amendment filed 5 October 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "special effect" dyes. The term "dyed" is not deemed to be new matter, however, "special effect" dyes are still believed to lack disclosure in both the specification and the priority document. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. Rejections set forth previously under this section are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 23-26** are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rohrbacher (USPN 4959189). **As to Claim 23**, Rohrbacher teaches fabricating a structural using fiber-reinforced plastic material that may be deformed by thermal molding comprising: placing a plastic film (3:22) which contains a pigmented layer (layer 4, interpreted to be a dyed layer, see 2:60) onto a mold (Fig. 5, item 18) which displays the topography of the surface of the structural part (4:33-44), deforming the film in conformance with the surface of the structural part (Fig. 5, items 18-20), and subsequently applying a fiber-reinforced plastic material using a process capable of applying that composition onto the backside. The context of the claim does not require any particular order of steps, and therefore this claim is anticipated under 35 USC 102(b). In the alternative that the claims are meant to require that the deforming step be performed in the forming mold and that the fiber-reinforced plastic is subsequently applied also in the forming mold, then it is submitted that this is an obvious reordering of steps that would have been obvious to the ordinary artisan.

As to Claim 24, in the Rohrbacher process, Rohrbacher suggests that a preformed film (20) is placed onto a forming mold of a molding press (Fig. 5, item 21), wherein the fiber-reinforced plastic material is in the form of a mat placed on the counterpiece of the molding press, and pressing to connect the pieces (Fig. 2, Fig. 5, arrow above 21). In the alternative, it

would have been obvious to place the film on the other molding half in order to support the film prior to pressing it against the sheet molding compound. **As to Claims 25 and 26**, Rohrbacher provides a sheet molding compound (SMC, Abstract) which is either a thermosetting or thermoplastic material. **As to Claim 29**, Rohrbacher teaches that the transparent layer can be eliminated (6:30-35) and in doing so, suggests a pigmented or painted (dyed) top layer. The Examiner interprets this painted or finished surface to be a "special effect" dye since it colors the surface.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 27** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrbacher (USPN 4959189) in view of Graefe (US 5,074,770). Rohrbacher teaches the subject matter of Claim 23 above under 35 USC 102(b), or in the alternative, under 35 USC 103(a). **As to Claim 27**, Rohrbacher teaches a preformed sheet inserted into a mold (Fig. 5), a fiber mat placed under the cavity of the film, and the mold is closed until a resin hardens (4:49-51). Rohrbacher is silent to the injection of the resin. However, in a first view this is merely a rearrangement of prior art process steps since Rohrbacher teaches applying resin to fibrous material before placing the fibrous material in the mold. However, one would have found it obvious to apply the resin to the fibrous material at any point in the process. Additionally or alternatively, Graefe teaches a

process in which a film is placed in a mold (Fig. 5, item 16), a fibrous layer is placed behind it (Fig. 5, item 30), and resin is injected after closing the mold (8:5-6). The injected resin contains a catalyst or initiator (13:10-15) which would act as a hardener when combined with the resin. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Graefe into that of Rohrbacher because (a) Rohrbacher clearly suggests that a combination of resin and fiber should be applied against the backside of a film, and Graefe provides a process for applying a resin and fiber material against the backside of a sheet, or (b) one of ordinary skill would have recognized the resin injection of Graefe as an obvious alternative or substitute for the use of a sheet molding material disclosed by Rohrbacher to provide the same result, namely a facing sheet with reinforced backing material.

6. **Claim 28** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrbacher (USPN 4959189) in view of Furuya (US 6,150,026). Rohrbacher teaches the subject matter of Claim 23 above under 35 USC 102(b), or in the alternative, under 35 USC 103(a). **As to Claim 28**, Rohrbacher does teach a three layer film comprising a color layer (Fig. 2, 6:31-32), however, Rohrbacher is silent to coextrusion. Furuya teaches that it is known to provide a film useful in an exterior panel by coextrusion lamination (col. 12) before performing the skin and molding material against the back surface. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Furuya into that of Rohrbacher since one of ordinary skill would have recognized the Furuya coextrusion process as a substitutable or alternative process for achieving or fabricating the film material to be performed in the Rohrbacher process.

Response to Arguments

7. Applicant's arguments filed 5 October 2009 have been fully considered but they are not persuasive. The arguments are on the grounds that Rohrbacher does not teach a dyed film, but instead teaches a thermoplastic coating firmly bonded to a layer of pigment which is adhered to a flexible thermo-formable sheet.

8. These arguments are not persuasive. In a first embodiment of the Rohrbacher reference, Applicants' claim recites only "a plastic film...wherein the film comprises at least one dyed layer." The claim therefore requires a plastic film with a dyed layer. The arguments are not commensurate with the claim to the extent that the arguments suggest that a "dyed film" is required. Only a dyed layer is required in combination with a plastic film, *even a clear film*. This, the Examiner submits, is found in the combination of layers 4 and 5 of Rohrbacher. Even if Applicants' arguments are correct in asserting that the entire film must be "dyed," then it is submitted that the claim is still met by certain embodiments of Rohrbacher. For example, "[c]olored pigments or dyes can be incorporated into the thermoplastic polymeric sheet by using conventional techniques..." (Rohrbacher, 6:37-40, emphasis added). A plastic (or thermoplastic) sheet with a dyed layer is clearly present. If Applicants are interpreting "dyed layer" in a different manner than set forth above by the Examiner, then Applicants are invited to point out their interpretation of a dyed layer and specifically address the cited portions of the Rohrbacher reference, especially column 6, lines 37-40.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. DANIELS whose telephone number is (571)272-2450. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew J. Daniels/
Primary Examiner, Art Unit 1791
1/16/10